



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,543	12/17/2003	Torsten Gottschalk-Gaudig	WAS 0611 PUS / Wa 10239-S	8271
22045 7590 08/30/2010 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER LIGHTFOOT, ELENA TSOY	
			ART UNIT 1715	PAPER NUMBER
			MAIL DATE 08/30/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Advisory Action***

The amendment filed on August 24, 2010 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendment do not remove 112, second paragraph issues, which were addressed in the Final Office Action mailed on May 17, 2010.

***Response to Arguments***

Applicant's arguments filed August 16, 2010 have been fully considered but they are not persuasive.

Rejection under 35 U.S.C. § 112, second paragraph

Applicants submit that the amendment should be entered to reduce issues on appeal, should appeal be necessary.

The Examiner disagrees. The amendment of claim 15: "I and II being used in total amount of ..." still renders the claim indefinite because it is not clear whether **each** of I and II or the sum of I and II is used in total amount of ....

Rejection of claims 15- 17, 19, and 30 - 36 under 35 U.S.C. § 103(a) over Endo et al. JP 04298538 A ("Endo") in view of Fitzgerald et al. U.S. Patent No. 5,623,028 ("Fitzgerald") and Ward et al. U.S. Patent No. 5,573,189 ("Ward")

Applicants maintain the same arguments as those in Remarks after Final Rejection mailed on 5/17/2010.

The Examiner disagrees with Applicants' arguments for the reasons discussed in Advisory Action mailed on 8/20/2010.

It is noted again that:

First of all, in contrast to Applicants' assertion, **Endo is not limited to wet silica particles** since Endo discusses silica particles containing 1-30 groups/nm<sup>2</sup> with an average particle size of 0.1-5 microns (See Transl. P16) in which 30-70% of the total silanol groups are blocked by a silane coupling agent (See Claim) without any reference to wet silica. Endo

Art Unit: 1715

mentions only once that the silica particles used in his invention for blocking can be made by wet process (See P11). The main requirement of Endo for the silica particles is to contain 1-30 groups/nm<sup>2</sup>. Endo teaches *nowhere* that suitable silica particles should be *spherical* and should be made by *wet process*. Therefore, from reading Endo as whole, it is clear that any silica particles would be suitable for his invention as long as they have 1-30 groups/nm<sup>2</sup> and an average particle size of 0.1-5 microns.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENA Tsoy LIGHTFOOT whose telephone number is (571)272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1715

August 29, 2010

/Elena Tsoy Lightfoot/